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WILHELM LAW SERVICE, S.C.  
100 W LAWRENCE ST  
THIRD FLOOR  
APPLETON, WI 54911

EXAMINER

ARAJ, MICHAEL J

ART UNIT PAPER NUMBER

3733

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/627,137

Applicant(s)

PAUL, KAMALJIT S.

Examiner

Michael J. Araj

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 17-35 and 41-67 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-35 and 41-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date see continuation.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

Continued from 3) 2/22/2005, 2/13/2004, 12/8/2003

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Figure 9 in the reply filed on September 19, 2005 is acknowledged. The traversal is on the ground(s) that any claim which depends from an allowable generic claim cannot be properly defined as a patentably distinct invention. This is not found persuasive because these claimed inventions are distinct. For examination purposes and election is necessary. Applicant is reminded that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

The requirement is still deemed proper and is therefore made FINAL.

It is acknowledged that applicant believes claims 1-15, 18-35 and 40-67 read on the elected species. The Examiner disagrees. Figure 9 does not appear to show at least all except for to of said bone-fastener-receiving apertures comprising of slots, thus enabling longitudinal movement of such bone fasteners in said slots. Claims 14, 15 and 40 have been withdrawn from this examination.

Claims 14-17 and 36-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Applicant timely traversed the restriction (election) requirement in the reply filed on September 19, 2005.

### ***Double Patenting***

Claims 1-67 are rejected on the ground of nonstatutory double patenting over claims 1-100 in U. S. Patent No. 6,755,833 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Current application appears to be broader than the previously patented claims.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Objections***

Claim 9 and 10 are objected to because of the following informalities: The claims are identical to each other. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 9-11, 22-24, 59 and 67 are rejected, as understood, under 35

U.S.C. 102(b) as being anticipated by Errico et al. (U.S. Patent No. 5,876,402).

Errico et al. disclose a spinal plate (100) having a length comprising a top and bottom surface and a plurality of bone-fastener-receiving apertures with a resiliently movable retaining element (180) mounted to said spinal plate and extending between first and second ones of said bone-fastener-receiving apertures (110,112) and extending into at least one of said bone-fastener-receiving apertures (see Figure 6). Said retaining element comprises a resiliently movable band, a length of said band extending alongside, and extending across a portion of one corresponding aperture. Also disclosed is a retaining band mounted to said spinal plate and extending into at least one of said bone-fastener-receiving apertures and causes an automatic blocking feature of a bone fastener when driven through said aperture. The apertures are tapered making the top length greater than the respective lower width. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Errico et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches,

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but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 1, 12, 18, 41-43, 48-51 and 58 are rejected, as understood, under 35 U.S.C. 102(e) as being anticipated by Needham et al. (U.S. Patent No. 6,533,786).

Needham et al. disclose a spinal plate (30) having a length comprising a top and bottom surface and a plurality of slot-shaped bone-fastener-receiving apertures (32) with a resiliently movable retaining element (33) extending substantially along the full length of the plate that is mounted to said spinal plate and extending between first and second ones of said bone-fastener-receiving apertures (32) and extending into at least one of said bone-fastener-receiving apertures. Said retaining element comprises a resiliently movable band, a length of said band extending alongside, and extending across a portion of one corresponding aperture. Needham et al. also disclose an intermittent channel (39) extending along the length of the spinal plate and intermittently expressed adjacent the apertures where a retaining band is mounted and is used in consequence to activate a blocking feature of said spinal plate assembly. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Needham et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation

does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference.

Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claims 1, 12, 19, 50, 51 and 58 are rejected, as understood, under 35 U.S.C. 102(e) as being anticipated by Assaker et al. (U.S. Patent No. 6,653,525).

Assaker et al. disclose a spinal plate (1) having a length comprising a top and bottom surface and a plurality of slot-shaped bone-fastener-receiving apertures (12) with two resiliently movable retaining elements (22) extending between first and second ones of said bone-fastener-receiving apertures (12) and extending into at least one of said bone-fastener-receiving apertures. Said retaining element comprises a resiliently movable band, a length of said band extending alongside, and extending across a portion of one corresponding aperture. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Assaker et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is



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intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8, 13,20, 21,25-35 are rejected, as understood, under 35 U.S.C. 103(a) as being unpatentable over Needham et al. (U.S. Patent No. 6,533,786).

Needham et al. disclose the claimed invention except for the device being made of different materials such as implantable plastics and metals and having a second movable band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create this spinal plate assembly with the disclosed materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to claim 20, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Needham having a second band, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 9, 10, 23 and 24 are rejected, as understood, under 35 U.S.C. 103(a) as being unpatentable over Errico et al. (U.S. Patent No. 5,876,402).

Errico et al. disclose the claimed invention except for the device being made of different materials such as implantable plastics and metals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create this spinal plate assembly with the disclosed materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Araj whose telephone number is 571-272-5963. The examiner can normally be reached on M-F 8am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJA



EDUARDO C. ROBERT  
PRIMARY EXAMINER